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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,232	07/24/2000	JOHN ROGER SAMPSON	SAMP-US1	2557

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EXAMINER
LOPEZ, CARLOS N

ART UNIT	PAPER NUMBER
1731	

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/582,232	SAMPSON, JOHN ROGER	
	Examiner	Art Unit	
	Carlos Lopez	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 May 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *31-39 and 48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *31-39 and 48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1) Claims 31, 34-39 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hedge (US 3805803) in view of Hayden et al (US 5109876). Hedge discloses a tobacco rod comprising a blend of shredded tobacco and reconstituted tobacco (Example 2). The reconstituted tobacco is treated with activated carbon having a particle size less than 150 microns and may comprise up to 50% by weight (Column 1,lines 20ff). The reconstituted tobacco may be in the form of a sheet (Column 1, lines 57-62). Hedge is silent disclosing the claimed porosity of the tobacco rod wrapper. However, as taught by Hayden et al wrappers typically have an inherent porosity below 400 C.U (Column 3, lines 53-64). Hence, at the time the invention was made it would have been obvious to a person of ordinary skill in the art to wrap Hedge's tobacco rod with a conventional cigarette wrappers absent any indication by Hedge.

Additionally, in view that the cigarette resulting from teachings of Hedge and Hayden would meet the claimed structural limitations, a reduced sidestream smoke as recited in Applicant's claim 31.

As for claim 35, activated carbon particles would be expected to reduce aldehyde content of the mainstream smoke.

As for claim 48, in view that the teachings of Hedge and Hayden meet the structural limitations claimed by applicant such as activated carbon particles in the tobacco, a reduction in sidestream smoke would be expected.

2) Claims 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hedge (US 3805803) in view of Hayden et al (US 5109876) as applied to claim 31 above and in further view of Raker et al (US 5261425). Hedge and Hayden are silent disclosing sources of carbon. However, the claimed sources of carbon are well known in the art as disclosed by Raker (Column 12, lines 40ff). Hence, at the time the invention was made it would have been obvious to a person of ordinary skill in the art to use carbon particles with the cigarette resulting from the combination Hedge and Hayden with conventional sources of carbon particles as taught by Raker et al.

Response to Arguments

Applicant's arguments filed 5/23/03 have been fully considered but they are not persuasive. Applicant argues the following "Hedge relates to a reduction of mainstream yields and does not contemplate a reduction in sidestream smoke. Hayden et al. discloses wrappers for the production of ash and burn characteristics in a smoking article without undesirable off-taste or off-aroma to the smoke produced when smoked, the wrappers having an inherent porosity below 400 coresta, There is, however, no suggestion of the use of a wrapper specifically having a permeability of at least 20 coresta, and no suggestion of the wrappers being used to effect a reduction in sidestream smoke. A combination of the teachings of Hedge and Hayden et al, would thus not result in the claimed invention. It would not be obvious to a person skilled in the art to combine these documents." Applicants argues that Hedge nor Hayden provide a smoking article having a wrapper

permeability being sufficient to prevent the smoking article from being self-extinguishing and having a reduced sidestream smoke.

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. Hence, Applicant's main arguments directed to distinguishing the apparatus claims using functional limitations is moot Teachings of Hedge and Hayden provide for the claimed structural limitations such as the claimed filler content and wrapper permeability. Thus, the apparatus resulting from the teachings of Hedge and Hayden sharing the same structural features as claimed by applicant would be expected to meet the functional limitations argued by applicant.

As noted above Hedge discloses a tobacco rod comprising a blend of shredded tobacco and reconstituted tobacco (Example 2). The reconstituted tobacco is treated with activated carbon having a particle size less than 150 microns and may comprise up to 50% by weight (Column 1,lines 20ff). The reconstituted tobacco may be in the form of a sheet (Column 1, lines 57-62). Hedge is silent disclosing the claimed porosity of the tobacco rod wrapper. However, as taught by Hayden et al wrappers typically have an inherent porosity below 400 C.U (Column 3, lines 53-64). Thus absent any indication by Hedge regarding the permeability of the wrapper, it would have been obvious to one of ordinary skill in the art to have used conventional wrappers such as shown by Hayden to have a porosity of below 400 coresta.

In response to applicant's argument that a smoking article having the claimed filler composition and wrapper porosity of at least 20 CU wherein the wrapper

permeability insufficient to prevent the smoking article from being self-extinguishing and having a reduced sidestream smoke, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is (703) 605-1174. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (703) 308-1164. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

STEVEN P. GRIFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

C.L